

The Enablement Requirements
The IP High Court
Case H19 (Gyoke) No. 10181 decided on February 27, 2008

Facts

The application relates to “Devices for Forming a Stack Extending Perpendicular to Standing, and Sequential Printed Sheets” filed by a Swiss company. The patent family of the present application includes US 5,515,667 A1 and EP 0 623 542 B1

The Japan Patent Office (JPO) rejected Patent Application No.6-93392 for failing to meet the enablement requirements. However, the Tokyo Appellate Court (currently called “IP High Court”) remanded the case to the Board of Appeals, holding that the description and drawings will be enough for a skilled person to understand and practice the invention.

JPO v. IP High Court

Opinion 1.

-JPO : Neither the specification nor the drawings describe a driving mechanism of the separating device 8, the separating elements 9, and the support elements 10. Thus, a skilled person cannot practice the invention.

-The IP High Court : The separating elements 9 and the support elements 10 move in a front-back direction and a vertical direction. In the front-back direction, the separating elements 9 and the support elements 10 follow the stack 7 at a speed corresponding to the formation of the stack 7. The separating elements 9 and the support elements 10 vertically rise to support and divide the stack 7, and fall to step back in preparation for the following operation of the support mechanisms 4 and 11. Thus, the operations of the separating elements 9 and the support elements 10 will be feasible for a skilled person.

Opinion 2.

-JPO : Neither the specification nor the drawings describe in detail a mechanism and operation of the plate hopper 13.

- The IP High Court : A skilled person could understand that the hopper 13 supports the pair of printing plates 5 and 12, which define the ends of the stack 7. The hopper 13 is formed to allow the support mechanisms 4 and 11 to accommodate the printing plates 5 and 12 (see claim 10). Thus, the printing plates 5 and 12 are removable from the hopper 13 at a location corresponding to the printing plates 5 and 12. Because these operations are understandable, it will be unnecessary to fully describe the mechanism of the hopper 13. Further, the hopper 13 may be fixed. Thus, a skilled person could understand the hopper 13 based on the disclosure of the specification and drawings.

Opinion 3.

-JPO: The relationship between the support mechanism 4 and the guide rail 19 (Fig.

1) is unclear. Further, because the driving mechanism of the support mechanism 11 is not described, its operation is unclear.

-The IP High Court : The specification clearly describes that the guide rails 19 and 20 form the guide arrangement 6, and that the support mechanisms 4 and 11 travel along the guide rails 19 and 20. Further, as discussed above, the operation of the support mechanism 11 is easily understood. The specification of the present application describes “a pneumatic or hydraulic actuating means, such as plunger-cylinder units, can be used to drive the support mechanism 11”. Thus, by carefully reading the specification, a skilled person could understand the driving mechanism and its operation.

Opinion 4.

-JPO : Because Fig. 1 does not show the belt 45, its location is unclear. Thus, the relationship between the belt 45 and the separating device 8 is unclear.

- The IP High Court : The specification says “a stack support 3 is provided by the belt 45, at least in the front region of the stack formation segment.” Thus, a skilled person could understand that the belt 45 is shown in a left-half of Fig.1 under the stack support 3.

The specification says “the stack support 3 is provided by the belt 45, so that optional precompression of stack 7 can be achieved.” However, the belt 45 is not relevant to divide the stack 7. In fact, there is not only a functional but also a structural relationship between the belt 45 and the separating device 8. Thus, a skilled person will not need to know the relationship between the belt 45 and the separating device 8.

Conclusive Opinion

The IP High Court reasoned that a skilled person could understand by referring to Figs. 1 and 2 that the essence of the invention resides in the conveyor 2 for conveying the printed sheets vertically downwards wherein the sheets are placed on and the horizontal stack support 3 disposed below the conveying device, and also for accumulating the printed sheets on the stack support 3 so as to make the stack 7. The printed sheets of the stack 7 are vertically placed on the stack support 3. Figs.2-4 show the separating device 8 that includes a pair of separating elements 9 and the pair of support elements 10. These separating elements 9 and the support elements 10 divide the stack 7 into two blocks. Fig. 1 shows the pair of support mechanisms 4 and 11 sandwiching the divided block of the stack 7, and a tying belt 47 tying the divided block of the stack 7.

【Note】

In many cases, Japan Patent Office severely requests enablement requirements to explicitly describe devices in detail in the Specification and the Drawings. In this case, the Patent Office and the Tokyo Appellate Court discussed lack of some explicit descriptions.

-Figs.1-8 of the present application is attached for reference

Fig.1

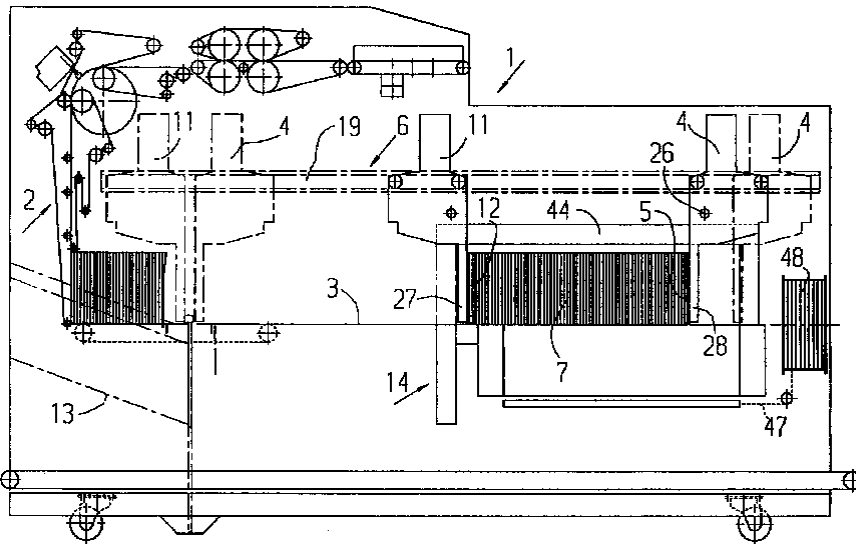


Fig.2

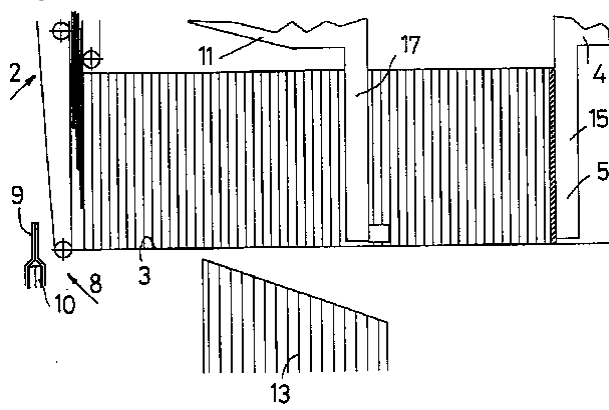


Fig.3

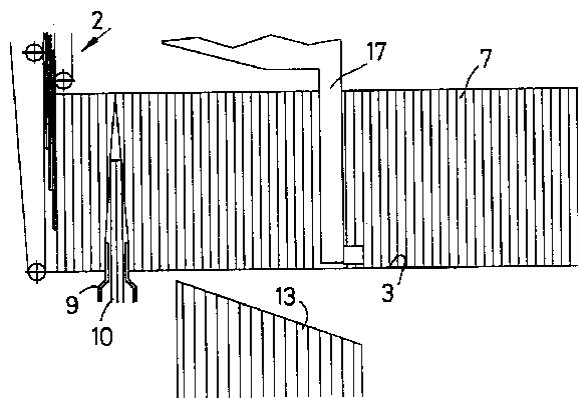


Fig.4

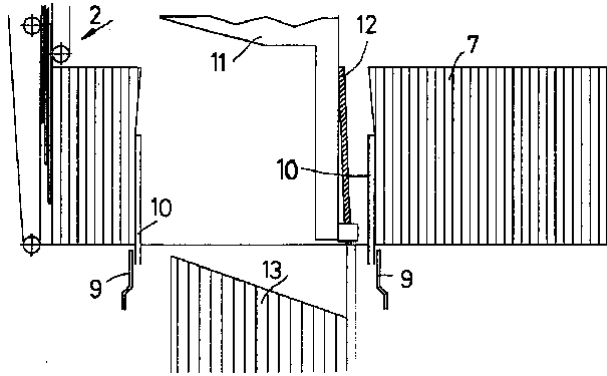


Fig.5

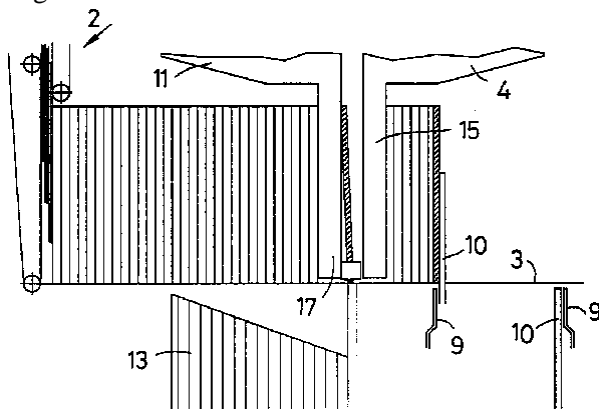


Fig.6

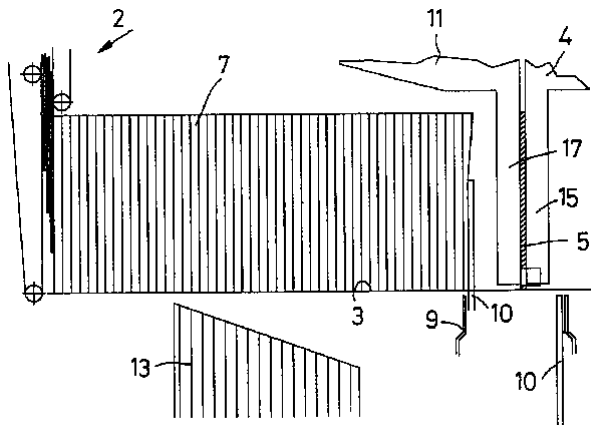


Fig.7

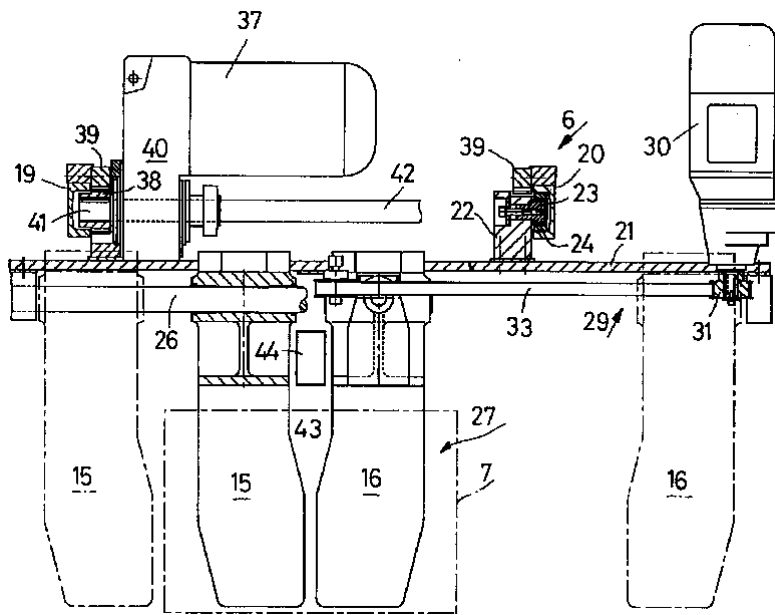


Fig.8

